



GP/2152

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Group Art Unit: 2152

**Michael K. Malone, Jon David Loucks,
Robert K. Terhune III, and Cameron W. Cotrill**

Application No. 09/760,148

Filed: January 12, 2001

For: **DISTRIBUTED GLOBALLY ACCESSIBLE
INFORMATION NETWORK**

Date: January 17, 2002

Examiner:

I HEREBY CERTIFY THAT THIS CORRESPONDENCE
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TRANSMITTAL LETTER

TO THE COMMISSIONER FOR PATENTS:

Enclosed for filing in the above-referenced application are the following:

- ☒ Information Disclosure Statement
- ☒ Form PTO-1449, together with copies of cited references

The Commissioner is hereby authorized to charge any additional fees which may be required in connection with filing of these papers, or credit overpayment, to Account No. 19-4455. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

**Michael K. Malone, Jon David Loucks,
Robert K. Terhune III, and
Cameron W. Cotrill**

By *Paul S. Angello*
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Attorney Docket No. 45596/2:2



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INFORMATION DISCLOSURE STATEMENT

TO THE COMMISSIONER FOR PATENTS:

1. Pursuant to their duty of disclosure, applicants present for the Examiner's consideration the documents listed on the accompanying Form PTO-1449.
 - ☒ Copies of the documents are enclosed.
 - ☐ Copies (a copy) of document(s) _____ are (is) not enclosed because they are already of record in U.S. Pat. Application No. _____, filed _____, which this application relies on for an earlier filing date under 35 U.S.C. § 120. (37 C.F.R. § 1.98(d).)
2. ☐ Applicant(s) draw(s) the Examiner's attention to the enclosed copy of copending U.S. Pat. Application No. _____, filed _____, for _____, which is cited in this application.
3. This information disclosure statement is being submitted:
 - (1) ☒ Within three months of the filing date of a national application other than a continued prosecution application under 37 CFR 1.53(d); within three months of the date of entry of the national stage as set forth in 37 CFR 1.491 in an international application; before the mailing of a first Office action on the merits; or before the mailing of a first Office action after the filing of a request for continued examination under 37 CFR 1.114. (No statement under 37 CFR 1.97(e) is required.)
 - (2) ☐ After the period set forth in paragraph 1a, but before the mailing date of either a final action, a notice of allowance, or an action that otherwise closes prosecution in the application. (Check box i. or ii.)

- i. ☐ A \$180.00 information disclosure statement submission fee set forth in 37 CFR 1.17(p) is enclosed.
 - ii. ☐ A statement specified by 37 CFR 1.97(e) is set forth below.
- (3) ☐ After the mailing date of a final action or notice of allowance and on or before payment of an issue fee. A statement specified by 37 CFR 1.97(e) is set forth below. Enclosed is a \$180.00 information disclosure statement processing fee set forth in 37 CFR 1.17(p).
4. ☐ The attorney or agent signing below hereby states that:
- ☐ each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the information disclosure statement; or
 - ☐ no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the person signing the certification after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in 37 CFR 1.56(c) more than three months prior to the filing of the information disclosure statement.
5. ☐ Applicants set forth below concise explanations of the relevance of each document not in the English language and/or selected documents in the English language.
6. ☒ Applicants present for the Examiner's consideration the following excerpt from *A&M Records, Inc. v. Napster, Inc.*, 239 F.3d 1004 (9th Cir. 2001), describing technical aspects of Napster.

"Napster facilitates the transmission of MP3 files between and among its users. Through a process commonly called "peer-to-peer" file sharing, Napster allows its users to: (1) make MP3 music files stored on individual computer hard drives available for copying by other Napster users; (2) search for MP3 music files stored on other users' computers; and (3) transfer exact copies of the contents of other users' MP3 files from one computer to another via the Internet. These functions are made possible by Napster's MusicShare software, available free of charge from Napster's Internet site, and Napster's network servers and server-side software. Napster provides technical support for the indexing and searching of MP3 files, as well as for its other functions, including a "chat room," where users can meet to discuss music, and a directory where participating artists can provide information about their music.

"A. Accessing the System.

In order to copy MP3 files through the Napster system, a user must first access Napster's Internet site and download [FN1] the MusicShare software to his individual computer. See <http://www.Napster.com>. Once the software is installed, the user can access the Napster system. A first-time user is required to register with the Napster system by creating a "user name" and password.

FN1. "To download means to receive information, typically a file, from another computer to yours via your modem.... The opposite term is upload, which means to send a file to another computer."
United States v. Mohrbacher, 182 F.3d 1041, 1048 (9th Cir.1999)
(quoting Robin Williams, Jargon, An Informal Dictionary of Computer Terms 170-71 (1993)).

"B. Listing Available Files.

If a registered user wants to list available files stored in his computer's hard drive on Napster for others to access, he must first create a "user library" directory on his computer's hard drive. The user then saves his MP3 files in the library directory, using self-designated file names. He next must log into the Napster system using his user name and password. His MusicShare software then searches his user library and verifies that the available files are properly formatted. If in the correct MP3 format, the names of the MP3 files will be uploaded from the user's computer to the Napster servers. The content of the MP3 files remains stored in the user's computer.

"Once uploaded to the Napster servers, the user's MP3 file names are stored in a server-side "library" under the user's name and become part of a "collective directory" of files available for transfer during the time the user is logged onto the Napster system. The collective directory is fluid; it tracks users who are connected in real time, displaying only file names that are immediately accessible.

"C. Searching For Available Files.

Napster allows a user to locate other users' MP3 files in two ways: through Napster's search function and through its "hotlist" function.

"Software located on the Napster servers maintains a "search index" of Napster's collective directory. To search the files available from Napster users currently connected to the network servers, the individual user accesses a form in the MusicShare software stored in his computer and enters either the name of a song or an artist as the object of the search. The form is then transmitted to a Napster server and automatically compared to the MP3 file names listed in the server's search index. Napster's server compiles a list of all MP3 file names pulled from the search index which include the same search terms entered on the search form and transmits the list to the searching user. The Napster server does not search the contents of any MP3 file; rather, the search is limited to "a text search of the file names indexed in a particular cluster. Those file names may contain typographical errors or otherwise inaccurate descriptions of the content of the files since they are designated by other users." Napster, 114 F.Supp.2d at 906.

“To use the "hotlist" function, the Napster user creates a list of other users' names from whom he has obtained MP3 files in the past. When logged onto Napster's servers, the system alerts the user if any user on his list (a "hotlisted user") is also logged onto the system. If so, the user can access an index of all MP3 file names in a particular hotlisted user's library and request a file in the library by selecting the file name. The contents of the hotlisted user's MP3 file are not stored on the Napster system.

“D. Transferring Copies of an MP3 file.

To transfer a copy of the contents of a requested MP3 file, the Napster server software obtains the Internet address of the requesting user and the Internet address of the "host user" (the user with the available files). See generally *Brookfield Communications, Inc. v. West Coast Entm't Corp.*, 174 F.3d 1036, 1044 (9th Cir.1999) (describing, in detail, the structure of the Internet). The Napster servers then communicate the host user's Internet address to the requesting user. The requesting user's computer uses this information to establish a connection with the host user and downloads a copy of the contents of the MP3 file from one computer to the other over the Internet, "peer-to-peer." A downloaded MP3 file can be played directly from the user's hard drive using Napster's MusicShare program or other software. The file may also be transferred back onto an audio CD if the user has access to equipment designed for that purpose. In both cases, the quality of the original sound recording is slightly diminished by transfer to the MP3 format.”

7. [X] Applicants present for the Examiner's consideration the following information about Internet searching technology.

COMPARISON SHOPPING ENGINES

A number of Internet web sites, such as MySimon.com, operate as comparison shopping engines, which usually operate in the same basic way. The purpose of these sites is to allow users to view the prices of a number of different web merchants for a particular product. To accumulate these product data, the engine periodically “spiders” each of the online merchant's web sites, harvesting price and product information. Spidering is, essentially, programmatically browsing all of the pages of a particular web site and extracting information from the HTML pages. All of the harvested information is then stored in a central database. When a user comparison shops for a product, the engine queries the central database for merchant pricing information, returning links to product pages at each merchant's web site.

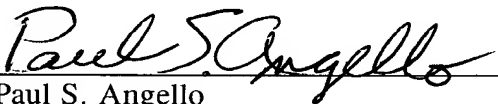
INTERNET SEARCH ENGINES

Internet web sites often offer search functionality. Whether Internet web sites search a single web site or attempt to search the entire Internet (Google., for example), the basic search methodology is often the same. This method entails pre-building a central database of indexed content and searching that database only for results. The contents of the central database are often built through “spidering.” Spidering is, essentially, programmatically browsing all of the pages of a particular web site and extracting information from the HTML pages. Typically, the HTML pages are programmatically indexed, and this information is stored in the central

database. When a user searches for information, the search engine queries the central database only against the digested information, returning links to specific web pages.

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